UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,275	07/11/2001	Scott Forstall	04860.P2674	2060

7590   01/12/2006

James C. Scheller, Jr.
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER
ALAM, SHAHID AL

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/904,275	FORSTALL ET AL.
	Examiner	Art Unit	
	Shahid Al Alam	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18,22-39,43-60 and 64-107* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,15-18,22,23,36-39,43,44,57-60,64,65 and 78-107* is/are rejected.

7)☒ Claim(s) *3-14,24-35,45-56 and 66-77* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1 – 18, 22 – 39, 43 – 60, 64 – 107 are pending in this Office action.

Response to Arguments

2.   Applicant's arguments filed on October 12, 2005 have been fully considered but

they are not persuasive for the following reasons.

Applicant's main argument is that APA does not teach "an indicator". Examiner

respectfully disagrees as argued.

Examiner is entitled to give claim limitations their broadest reasonable

interpretation in light of the specification.

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest

reasonable interpretation consistent with the specification.' Applicant always has the

opportunity to amend the claims during prosecussion and broad interpretation by the

examiner reduces the possibility that the claim, once issued, will be interpreted more

broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

Applicant gave several explanations about an indicator and how APA

distinguishes with respect to instant claims (see pages 23 – 24 of the Remarks).

Applicant gives some limitation such as "the indicator" being separate from an

extension, being user selectable for a single file . . . , to indicate how to display an

extension of the file. However, Applicant failed to show whether an indicator is a

selector or a pointer or any other user interface. If Applicant is thinking an indicator is a

selector, then APA on page 1 lines 10 – 12, teaches this selector (*a user interface associates a type of files with an application program so that a standard user operation on one of the files starts the associated application program to operate on that file, such as <u>a mouse click</u>; . . .)*.

Applicant claimed in the dependent claims that an indicator is a bit, a file, an entry in a file, **or** an entry in a database. Applicant admits that the user's preference is found to show all extensions in operation 404, operation 406 displays a displayed name of the file in the user interface (if "indicator" is user interface, APA shows this in the admitted prior art portion and if "indicator" is a file or entry of a file as claimed in the dependent claims, then it also shows in the APA portion. The displayed name (*an entry in a file*) contains both the filename (*a file, an entry in a file, or an entry in a database*) and the extension. The user's preference is to show no extension, operation 408 displays a displayed name of the file and **operation 410 checks** (may be an indicator, which checks about the file) whether the extension of the file is known to the system or not.

Thus, Applicant's claim language is not clear enough as to the meaning of an indicator.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 102

3.　　The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 15 – 18, 22, 23, 36 – 39, 43, 44, 57 – 60, 64, 65 and 78 – 107

rejected under 35 U.S.C. 102(a) as being anticipated by the Applicants Admitted Prior

Art (hereinafter "APA").

With respect to claim 1, APA discloses a method of managing file extensions in a

digital processing system with a user interface and a plurality of files, each file having a

name that comprises a filename and an extension (Page 1, lines 17 – 19, page 2, lines

9 – 15 and Figure 2), said method comprising:

associating a file with an indicator, which is separate from an extension (page 2,

lines 8 – 17; the displayed name contains both the file name and the extension . . . the

displayed name does not contain the extension) and

which is user selectable for a single file in the plurality of files in said digital

processing system (page 2, lines 19 – 23)

without effecting other files in the plurality of files (page 3, lines 11 – 17) and

which indicates how to display an extension of the file (page 2, line 15); and

displaying a displayed name of the file in the user interface in a style

determined by said indicator (page 2, lines 19 – 22).

As to claim 2, the style is such that the displayed name contains the extension of the file only when said indicator is for showing the extension of the file (page 2, lines 19 – 22).

As to claim 15, exporting both the filename of the file and the extension of the file to a remote system when the file is transferred to the remote system (page 3, lines 4 – 6).

As to claim 16, exporting said indicator to the remote system when the file is transferred to the remote system (page 3, lines 4 – 6).

As to claim 17, importing both the filename of the file and the extension of the file from a remote system when the file is transferred from the remote system (page 3, lines 4 – 6).

As to claim 18, importing said indicator from the remote system when the file is transferred from the remote system (page 3, lines 4 – 6).

Claims 22, 23 and 36 – 39 are essentially the same as claims 1, 2 and 15 – 18 except that it sets forth the claimed invention as a machine-readable media rather than a method and rejected for the same reasons as applied hereinabove.

Claims 43, 44 and 57 – 60 are essentially the same as claims 1, 2 and 15 – 18 except that it sets forth the claimed invention as a digital processing system rather than a method and rejected for the same reasons as applied hereinabove.

Claims 64, 65 and 78 – 85 are essentially the same as claims 1, 2 and 15 – 18 except that it sets forth the claimed invention as a processing system rather than a method and rejected for the same reasons as applied hereinabove.

With respect to claim 86, APA discloses a processing system comprising:

a processor; a display device coupled to said processor, said display device displaying a user interface (figure 2, item 402); and

a memory coupled to said processor, said memory storing in a file container a first file which has a first extension and a first filename (page 2, lines 11 – 13), said memory storing in said file container a second file which has a second filename and a second extension (page 3, lines 4 – 11), said memory storing a first indicator that is specific for said first file and is separate from the first extension for the first file (page 2, lines 8 – 17; the displayed name contains both the file name and the extension . . . the displayed name does not contain the extension) and that indicates the first extension is displayed in the user interface in a first style using a first displayed name, said memory storing a second indicator (page 2, lines 8 – 17; the displayed name contains both the file name and the extension . . . the displayed name does not contain the extension) that indicates the second extension is displayed in the user interface in a second style using a second displayed name, said processor detects a conflict in naming the first file and the second file (page 3, line 11 – page 4, line 6).

With respect to claims 87 and 88, subject matter of claims 87 and 88 are rejected in the analysis above in claims 1, 2 and 15 – 18 and these claims are rejected on that basis.

Subject matter of claims 89 – 98 are rejected in the analysis above in claims 1, 2 and 15 – 18 and 86 and these claims are rejected on that basis.

With respect to claims 99 – 107, the indicator is not a part of a name of the file

(APA discloses on page 1, lines 10 – 12 that a user interface associates a type of files

with an application program so that a standard user operation on one of the files starts

the associated application program to operate on that file, such as a mouse click; . . .).

Allowable Subject Matter

4.   Claims 3, 24, 45 and 66 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Contact Information

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-

4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00

P.M..

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Shahid Al Alam
Primary Examiner
Art Unit 2162

October 7, 2006